

## **II. RESPONSE TO OFFICE ACTION**

The Office Action rejected Claims 1-26. Reconsideration of the claims in light of the above amendments and the following remarks is respectfully requested. The Examiner's comments from the Office Action are reprinted below in 10-point bold type and are followed by Assignee's remarks.

### **A. Claim Rejections 35 USC § 112**

**Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The spring loaded pin recited in the claim appears to lack antecedent in the specification. Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, line 9 has no proper antecedent for "the predetermined height", also the clause "functionally associated" and "slidably associated" are vague (Applicant should consider changing them to more narrow clauses like attached). Claim 4 ends with a comma (,); if something missing from the claim. Claim 5 appears to have the term first leg and second leg inverted. As understood, member (410) is pivotally attached to the second leg (150), and the post (140) is on the first leg (140). See Fig 4. Claim 6, line 3, lacks antecedent for "the channel". Claim 10, line 1, lacks antecedent for "the locking means". Claim 22, line 2, lacks antecedent for "the desk", and in line 5 lacks antecedent for "the base tray". Further, claim 22 is reciting the user as part of the combination. Functional language, like the clause "adapted to" should be used.**

In an effort to move this case along, the following amendments were made to the claims to more particularly point out the claimed invention. Claim 1 has been cancelled, but the language in question has been addressed in claims 5, 6, and 13, and others now written in independent form.

Claim 8 has been amended herein, to refer to the spring as requested. Further, new claims 27 and 28 address the use of the pin in various embodiments. Claim 5 has been amended to invert reference to first and second legs; however, as it is noted that the disclosure is not limited to this embodiment ("Of course, in other embodiments, the member 410 may be pivotally attached to the first leg 140 with the post on the second leg 150." *see* ¶ 0049, ll.9-11 of original specification) independent claim 29 has been added representing alternative embodiments. Claims 6, 10, and 22 have been amended to provide antecedent basis; claim 22 has been amended to clarify that a user is not claimed. It is noted that the Office Action refers to making

narrowing amendments; however, it is believed the other amendments made herein for other reasons place the referenced claims in question in condition for allowance. It is believed all pending claims are therefore in condition for allowance.

**B. Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 9, 19, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Jerick (Pat No 5,581,023). The patent to Jerick discloses an adjustable device comprising a lower tray (55) and upper tray (56), four legs (62-65) having one end attached (functionally associated) to the upper tray, and the other end slidably attached (slidably associated) to the lower tray; the trays being substantially identical, wherein the height of the device can be adjusted by the user.

In an effort to move this case along, and without acquiescing to the characterization of the prior art as set forth in the Office Action, claim 1 has been cancelled herein. Assignee reserves the right to pursue without prejudice all originally-filed claims at a later date. Claim 9, 19 and 25, have been amended to depend from claims now believed to be in condition for allowance; claim 24 has been amended to include limitations from the apparatus claim 13 (allowable over the prior art in the office action).

**C. Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jerick. With respect to claim 2, the patent to Jerick can support a keyboard tray on its upper tray. With respect to claim 26, the use of pneumatic means in lieu of manual one is seen a mechanical expedient to facilitate the use of the device.

Claims 3, 4 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jerick in view of Ehrichs. The patent to Ehrichs shows another adjustable device having legs pivotally attached to an upper member. It would have been obvious to one skilled in the art at the time the invention was made to have provided the legs shown in Jerick's device pivotally attached to the upper tray to reduce manufacturing costs.

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jerick in view of Congleton (Pat No 6,296,312). The patent to Congleton shows a locking means as the one recited here. It would have been obvious to one skilled in the art at the time the invention was made to have provided the device shown by Jerick with a locking means as the one shown by Congleton to lock the device in a desired height.

In an effort to move this case along, and without acquiescing to the characterization of the prior art as set forth in the Office Action, claims 3, 4, and 10 have been cancelled herein. Assignee reserves the right to pursue all originally-filed claims at a later date. Claims 2 have been amended to depend from claims believed to be in condition for allowance. Original claims 21 and 26 depend from claims now believed to be in condition for allowance.

For the reasons set forth herein, it is believed all pending claims are in condition for allowance.

**D. Specification/Drawings**

The specification has been amended to change 3 to 10 on page 10, and the drawings have been amended as follows: the "H" as been detailed in Figures 1I, and the 540 is shown in Figure 5A, each being shown in the attached "replacement sheets." Pursuant to 37 C.F.R. § 1.121(d)(2), Assignee has provided sheets entitled "Annotated Marked Up Drawings," for the convenience of the Examiner. Assignee requests the Examiner to accept these replacement sheets of drawings. These amendments are proper, i.e. no new matter is being inserted into the specification, as each modification is supported in the text of the specification as originally filed.

**E. Allowable Subject Matter**

Claims 5-8, and 13-18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Assignee has written claims 5, 6, and 13 in independent form, to include all the limitations of the base claim and any intervening claims; as such, it is believed such claims are in condition for allowance. It is noted that claim 13 has been written in independent form as if depending from claim 9, with claim 10 now depending from 13. Further, the dependency of claims 2, 19, 20, and 25 have been amended to refer to claims now believed to be allowable.

Finally, Assignee points out that claim 20 was not rejected in the Office Action; however, in an effort to move this case along, claim 20 has been amended to more particularly point out the claimed invention.

**F. Conclusion**

The Examiner is invited to contact the undersigned attorney at 713.787.1478 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



Gregg A. Duffey  
Reg. No. 42,501  
Attorney for Assignee

HOWREY LLP  
750 Bering Drive  
Houston, Texas 77057  
(713) 787-1400

# Annotated Marked-Up Drawings

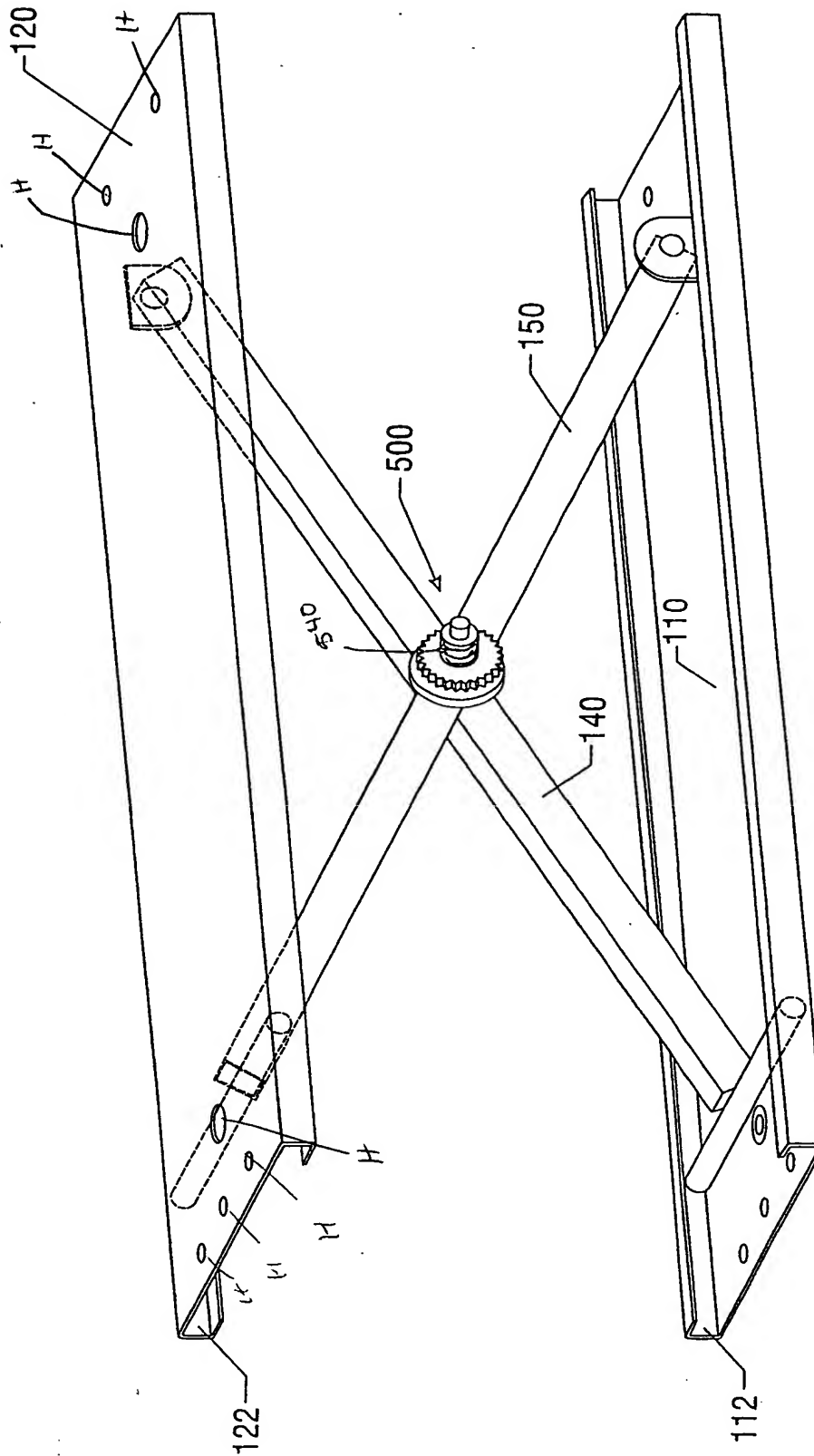


FIG.5A

# Annotated Marked-Up Drawings

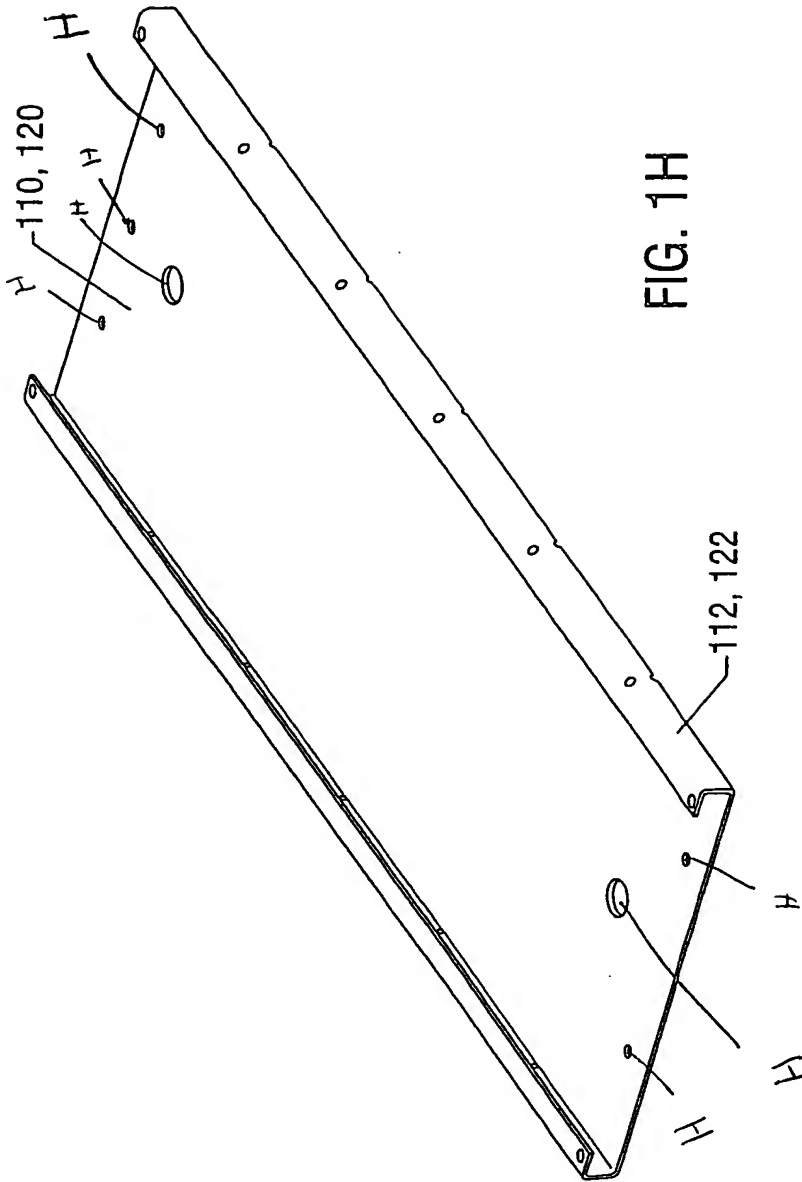


FIG. 1H

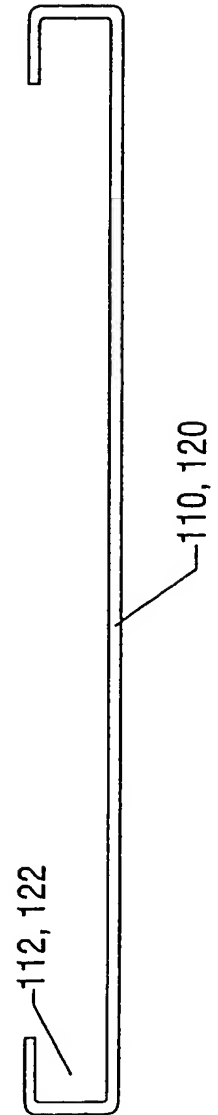


FIG. 1I